

REMARKS/ARGUMENTS

The Applicants have filed the present Amendment pursuant to 37 C.F.R. § 1.111 in reply to the outstanding Official Action dated October 8, 2003, and the Applicants believe the Amendment to be fully responsive to the Official Action for the reasons set forth below.

In the present Official Action, the Examiner first rejected Claims 6-14 pursuant to 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point and distinctly claim the subject matter that the Applicants regard as the invention. The Examiner further rejected Claims 6-7 and 12 pursuant to § 102(e), as allegedly anticipated by Schena, *et al.* (U.S. Patent No. 6,546,418) (hereinafter "Schena"). The Examiner lastly rejected Claims 1-5 pursuant to 35 U.S.C. § 103(a), as allegedly unpatentable over Schena in view of Perkowski (U.S. Patent No. 6,625,581).

At the outset and before addressing the rejections raised in the present Official Action, although not objected to by the Examiner, the Applicants have made an editorial correction to the specification as recited herein. More specifically, the Applicants have amended the incorrect reference number 174a to the correct reference number 74a in view of the present Fig. 8. The Applicants respectfully submit that no new matter has been entered via this amendment.

In addition, the Applicants have cancelled the dependent Claim 2 without prejudice or disclaimer, and have amended the independent Claim 1 with the subject matter of the cancelled Claim 2, as particularly recited herein, to better define the

invention. More specifically, the Applicants have amended Claim 1 to recite a portable information terminal apparatus comprising: a display element; a communication element; a reading element which reads access destination information indicated on a printed matter, the reading element including a scanner which reads an image on the printed matter and an extraction element which extracts the access destination information included in the image; a memory which stores the image; a control element which connects to an access destination corresponding to the access destination information through the communication element, receives contents from the access destination, and executes a browser for displaying the received contents on the display element, wherein the image stored in the memory is displayed on the display element as a bookmark image associated with the access destination information.

Furthermore, the Applicants have amended the independent Claim 6 consistently with the amendments to the independent Claim 1. More specifically, the Applicants have amended Claim 6 to recite an information provision method comprising: storing contents in a server accessible through a communication network, the contents being associated with an article on a printed publication, the printed publication including a contents locating information indicating a location of the contents, the contents locating information being printed within or in the vicinity of the article; reading an image on the printed publication and storing the image in a memory by a portable information terminal apparatus; extracting the contents locating information from the image by the portable information terminal apparatus; acquiring and displaying the contents by accessing the server through the communication network based on the contents locating information extracted by the portable information terminal apparatus; and displaying the image stored

in the memory as a bookmark image associated with the contents locating information by the portable information terminal apparatus. Support for the foregoing amendments to the independent Claims 1 and 6 is found in the present specification on page 14, lines 11-18, and page 16, line 11 – page 18, line 5. The Applicants respectfully submit that no new subject matter has been entered via the foregoing amendments.

Lastly, the Applicants have amended the dependent Claims 3, 4 and 8-14 for consistency with the independent Claims 1 and 6 from which the foregoing claims respectively depend, and for clarity of the subject matter in the respective dependent claims. The Applicants respectfully submit that no new subject matter has been entered via the foregoing amendments.

In traversing the rejection of Claims 6-14 pursuant to 35 U.S.C. § 112, second paragraph, the Applicants respectfully submits that the foregoing claims as amended are definite and distinctly claim the subject matter that the Applicants regard as the invention. More specifically regarding the independent Claim 6, the Applicants have clarified the storing step in which contents associated with an article on a printed publication are stored in a server accessible through a communication network, where the printed publication includes a contents locating information indicating a location of the contents. The Applicants have further expressly recited that the contents locating information is obtained by the steps of reading an image from the printer publication and extracting the contents locating information from the image. Still further the Applications have expressly recited a step of acquiring and displaying the contents by accessing the server through the network. Lastly, the Applicants have added a step of

displaying the image as a bookmark image associated with the contents locating information. The Applicants have further amended Claims 8-14 for consistency with the independent Claim 6 from which the foregoing claims respectively depend and for clarity of the subject matter in the respective dependent claims. The accounting file (ref. no 109) is described in the specification on page 27, line 19 – page 28, line 7, with reference to Fig. 9 and 11. The charge table in Claims 8-11 (ref nos. 501, 511, 521, 531) is described in the specification on page 28, line 8 – page 29, line 11, with reference to Figs. 12(a) – 12(d). Consequently, the Applicants respectfully submit that the foregoing claims as amended are definite and distinctly claim the subject matter that the Applicants regard as the invention.

In view of the foregoing, the Applicants respectfully request the Examiner to withdraw the rejection of Claims 6-14 pursuant to 35 U.S.C. § 112, second paragraph.

In traversing the rejection of the independent Claim 6 pursuant to 35 U.S.C. § 102(e), the Applicants respectfully submit that the primary prior art reference to Schena is deficient in that it fails to disclose displaying the image as a bookmark image associated with the contents locating information, as particularly recited in the independent Claim 6. Schena is directed to a method for managing printed medium activated revenue sharing domain name system schemas. More specifically, Schena discloses scanning a machine-readable code containing a link information corresponding to provider information from an object using a scanner and storing the machine-readable code in a memory. Schena further discloses extracting link information from the machine-readable code in the memory and obtaining user input information

corresponding to the provider information to be stored in the memory. Further yet, Schena discloses sending the link information and the user input information to a portal server via a network, the portal server receiving the link information and user input information and selecting a multimedia information sequence corresponding to the link information and the user input information. Schena also discloses sending the multimedia information sequence to a receiver via the network; the receiver receiving and storing the multimedia information sequence and playing the multimedia information sequence automatically or in response to a user request. Lastly, Schena discloses that the scanner and the receiver may or may not comprise a single device. However, to the contrary of the claimed invention, Schena does not disclose that its receiver and/or scanner device displays the scanned object as a bookmark image associated with its link information (that corresponds to the provider information on the portal server).

Consequently, the Applicants respectfully submit that Schena fails to disclose displaying the image (read by the scanner) as a bookmark image associated with the contents locating information, as particularly recited in the independent Claim 6.

In view of the foregoing, the Applicants respectfully request the Examiner to withdraw the rejection of Claim 6 pursuant to 35 U.S.C. § 102(e). The Applicants further respectfully request the Examiner to withdraw the rejection of Claims 7 and 12 pursuant to 35 U.S.C. § 102(e), based at least on their respective dependencies from the independent Claims 6.

In traversing the rejection of the independent Claim 1 pursuant to 35 U.S.C. § 103(a), the Applicants respectfully submit that the Schena-Perkowski

combination is deficient in that it fails to teach or suggest the displaying the image as a bookmark image associated with the access destination information, as particularly recited in the independent Claim 1. The Applicants respectfully submit that the argument presented hereinabove regarding the deficiency in the primary prior art reference to Schena is applicable here and as a consequence it is incorporated herein in its entirety. More specifically, the Applicants respectfully submit that Schena does not teach or suggest displaying the image as a bookmark image associated with the access destination information, as particularly recited in the independent Claim 1. The secondary prior art reference to Perkowski does not rectify the deficiency in Schena. Perkowski is directed to a method and system for delivering consumer product information to consumers over the Internet. More specifically, Perkowski teaches creating an UPN-encoded Consumer Product Information (CPIR) enabling Applet for each consumer product registered within a manufacturer-managed UPN/URL database management system. Perkowski further teaches encapsulating each CPIR-enabling Applet within an executable file and storing the file in the UPN/URL database management system. In addition, Perkowski teaches that each CPIR-enabling Applet is searchable and downloadable, for example, by retailers, advertisers or anyone having a legitimate purpose of disseminating such information within the stream of electronic commerce. After downloading and extraction from the executable file, the CPIR-enabling Applet is embedded within an HTML-encoded document associated with, for example, an EC-enabled store, on-line auction site, product advertisement, Internet search engine or directory, and the like. Lastly, Perkowski teaches that upon encountering such an Applet-encoded HTML document on the World Wide Web (WWW), the consumer need only perform a single mouse-clicking

operation to automatically execute the underlying CPIR-enabling Applet (on either the client or server side of the network), causing a UPN-directed search to be performed against the manufacturer-defined UPN/URL database, and the results thereof to be displayed in an independent Java GUI, without disturbing the consumer's point of presence on the WWW. However, just like the primary reference to Schena as argued above, the secondary reference to Perkowski fails to teach or suggest displaying the image (read by a scanner) as a bookmark image associated with the access destination information, as particularly recited in the independent Claim 1. In fact, Perkowski is unrelated to the present invention and is further completely silent as to this limitation.

In view of the foregoing, the Applicants respectfully request the Examiner to withdraw the rejection of Claim 1 pursuant to 35 U.S.C. § 103(a). The Applicants further respectfully request the Examiner to withdraw the rejection of Claims 3-5 pursuant to 35 U.S.C. § 103(a), based at least on their respective dependencies, whether direct or indirect, from the independent Claim 1.

In sum, the Applicants believe that the above-identified application is in condition for allowance and henceforth respectfully solicit the allowance of the application. If the Examiner believes a telephone conference might expedite the allowance of this application, the Applicants respectfully request that the Examiner call the undersigned, Applicants' attorney, at the following telephone number: (516) 742-4343.

Respectfully submitted,



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